

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, Applicants would like to thank the Examiner for the indication that claims 16-20 are allowed.

In the Official Action, the Examiner objects to the disclosure because "Fig. 1" on page 16, line 8 should be --Fig. 9-- and the cross reference should be amended to include the U.S. Patent Number. In response, the specification has been amended as suggested by the Examiner. Accordingly, it is respectfully requested that the objection to the disclosure be withdrawn.

In the Official Action, the Examiner objects to claims 12-15. With regard to claim 12, the Examiner argues that "anvil" recited therein should be changed to --impact mass--. With regard to claim 15, the Examiner argues that the plurality of cams recited therein requires a plurality of anvil surfaces and impact masses.

In response, claim 12 has been amended to change "anvil" with --impact mass-- as suggested by the Examiner.

Furthermore, claim 15 has been amended to recite that each of the two cams correspond with one of the two anvil surfaces and impact masses.

Accordingly, it is respectfully requested that the objection to claims 12-15 be withdrawn.

In the Official Action, the Examiner rejects claims 12-15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner

argues that the limitation "the spring" in claim 12 has insufficient antecedent basis in the claim. In response, "the spring" has been changed to --the biasing means--.

Accordingly, it is respectfully requested that the rejection of claims 12-15 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,243,109 to Anderson (hereinafter "Anderson"). Additionally, the Examiner rejects claims 12-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,474,091 to Russ (hereinafter "Russ").

With regard to the rejection of claims 1-11, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 102(b) for at least the reasons set forth below.

Claim 1 recites in relevant part "an impact mass movable along a path in communication with the impact stop." Furthermore, claim 1 recites "a spring disposed in the path for storing energy upon rotation of the driving member."

Firstly, Applicants disagree with the Examiner's assertion that the impact mass of Anderson is disposed in the path and in communication with the impact stop. The Examiner argues that such impact mass (16) is in communication with the impact stop through member 38. Applicants respectfully disagree. However, since the impact mass moves along a path towards the impact stop, Applicants respectfully submit that the spring of Anderson (18) is not disposed in such path, as clearly shown in Figure 5 of Anderson.

With regard to the rejection of claims 1-11 under 35 U.S.C. § 102(b), a manually operated impact tool having the features described above and as recited in independent claim 1 is nowhere disclosed in Anderson. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every

element of the claimed invention, arranged as in the claim,”¹ independent claim 1 is not anticipated by Anderson. Accordingly, independent claim 1 patentably distinguishes over Anderson and is allowable. Claims 2-11 being dependent upon claim 1 are at least allowable therewith as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-11 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 12-15, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 102(b) for at least the reasons set forth below.

Claim 12 recites in relevant part “at least one cam for engaging a surface of the driving member and for moving the at least one impact mass apart from the corresponding at least one anvil surface upon rotation of the cam and for releasing the driving member such that the biasing means pulls the at least one impact mass to impact the corresponding at least one anvil surface to create a torque around the axis.”

The Examiner argues that spring (8) of Russ acts to bias the anvil surface and impact mass together. Applicants respectfully disagree. The spring (8) of Russ only biases the ratchet wheel (6) to rotate in a certain direction and does not act to bias the anvil surface (cooperating with 12) and impact mass (12) together.

Further, the Examiner argues that the at least one cam (ratchet 6) of Russ acts to move the anvil surface and impact mass apart such that the biasing means (spring 8) pulls the impact mass to impact the anvil surface. Applicants again respectfully disagree. While the rotation of ratchet (6) of Russ may act to move the anvil surface and impact mass apart, the spring (8) certainly does not pull the impact mass to impact the anvil surface. The spring merely acts to bias the ratchet wheel of Russ.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

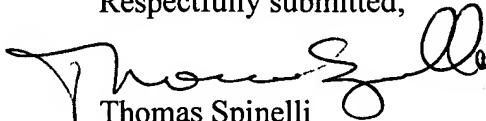
With regard to the rejection of claims 12-15 under 35 U.S.C. § 102(b), a manually operated impact tool having the features described above and as recited in independent claim 12 is nowhere disclosed in Russ. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"² independent claim 12 is not anticipated by Russ. Accordingly, independent claim 12 patentably distinguishes over Russ and is allowable. Claims 13-15 being dependent upon claim 12 are at least allowable therewith as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 12-15 under 35 U.S.C. § 102(b).

Lastly, In the Official Action, the Examiner rejects claims 1-11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,679,143. In response, in order to advance prosecution, Applicant files herewith a terminal disclaimer disclaiming any portion of the term of a U.S. patent that eventuates from the present application that extends beyond the term of U.S. Patent No. 6,679,143. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-11 under the judicially created doctrine of obviousness-type double patenting.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No. 39,533

Omnitek Partners LLC
111 West Main Street
Bayshore, New York 11706
631 807-9747

TS/ds
Enclosure (Terminal Disclaimer)